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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,612

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Peter D. Colburn JR.

2303-1-017N

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11/22/2004

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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/072,612

Applicant(s)

COLBURN ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. Claims 1, 2, and 5-14 are now pending in the application.
2. The application still lacks clear micrographic images. The Notice of Draftsperson's Patent Drawing Review (PTO-948) was included in the previous office action dated June 15, 2004. Applicant's intent to submit replacement formal drawings upon notification of allowable subject matter is acknowledged.
3. The objections to the specification are withdrawn in light of applicant's amendment.
4. The claim objection over claim 5 in paragraph 4 of action dated June 15, 2004 is maintained since the term "the multipolymer hard phase" still lacks antecedent basis.
5. The 35 U.S.C. § 112(2) rejection over claim 6 is maintained with respect to the inadequately described composition. Applicant's submission that one skilled in the art would recognize to use Formulas A and B in the alternative is insufficient to overcome the rejection since the claim itself is still unclear. In particular, claim 5, on which claim 6 is dependent, suggests that both low and high refractive index polymers are added by reciting "using auxiliary polymer additives" (emphasis added). It is suggested that applicant amend claims 5 and 6 to reflect that the formulas are used in the alternative as explained on page 8 of arguments dated September 25, 2004. It is noted that to avoid the addition of new matter, applicant is advised to submit a statement in the form of a declaration filed under 37 CFR § 1.132 to overcome the rejection.
6. The 35 U.S.C. § 112(2) rejection over claim 11 is withdrawn in light of applicant's amendment. However, the amendment to claim 11 creates a new problem which necessitates the objection in paragraph 7 below.

***Claim Objections***

7. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

The notched izod values recited in claim 11 of “at least about 1.0 ft-lb/in [at] sub-zero temperatures” does not further limit and is, in fact, contrary to the notched izod values of “up to about 1.0 ft-lb/in. at low temperatures below zero degree fahrenheit” recited in claim 1, on which claim 11 is dependent.

***Claim Rejections - 35 USC § 103***

8. Claims 1, 2, 5, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troy et al (US 5,599,854) in view of Toyo (UK 1,180,085) and Cutter (US 4,598,123).

The rejection set forth in paragraph 6 of action dated June 15, 2004 is incorporated here by reference.

The amendment to claim 1 limits the composition so that it is more distinctly and clearly defined with specific notched izod and haze values. Although Troy et al in view of Toyo and Cutter are silent with respect to the specific numerical properties presently claimed, it is the examiner's position that such properties are intrinsic given that the referenced composition is the same as applicant's, and a material and its properties are inseparable.

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9. Claims 5, 6, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troy et al in view of Toyo and Cutter et al, as applied to claims 1, 2, 5, 13, and 14 above, and further in view of Siol (US 4,985,504).

The rejection set forth in paragraph 7 of action dated June 15, 2004 is incorporated here by reference.

The amendment to claims 1 and 11 limit the composition so that it is more distinctly and clearly defined with specific notched izod and haze values. Although Troy et al in view of Toyo and Cutter and further in view of Siol are silent with respect to the specific numerical properties presently claimed, it is the examiner's position that such properties are intrinsic since they meet the present compositional limitations and a material and its properties are inseparable.

With respect to claim 11, evidence to support the examiner's position is found in Troy et al which discloses that its butadiene-based impact modifiers impart vastly improved izod impact properties at ambient temperature over conventional butadiene-based impact modifiers (see tables on cols. 7 and 8) and which reasonably suggests that desirable izod impact properties such as those presently claimed would be obtained at sub-zero temperatures. Moreover, the izod values at ambient temperature for a composition comprising the butadiene-based rubber with poly(vinyl chloride) are exemplified to be 1174 and 1014 J/m, i.e., 6.7 and 5.8 ft-lb/in, respectively (see tables on cols. 7 and 8), values which fall within the scope of the presently claimed value of *at least* 1 ft-lb/in.

10. Claims 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troy et al (US 5,599,854) in view of di Leone et al (US 4,085,166).

The rejection set forth in paragraph 8 of action dated June 15, 2004 is incorporated here by reference.

***Response to Arguments***

11. Applicant's arguments filed September 15, 2004 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Troy et al in view of Toyo and Cutter does not have a haze of about 1.1 % or less and a notched izod value of about 1.1 ft-lb/in. at low temperatures, (B) that Troy et al in view of Toyo and Cutter and further in view of Siol do not have a haze of about 1.1 % or less and a notched izod value of about 1.1 ft-lb/in. at low temperatures, and (C) that that Troy et al in view of di Leone et al does not have a haze of about 1.1 % or less and a notched izod value of about 1.1 ft-lb/in. at low temperatures.

It is noted that case law holds that “products of identical chemical composition cannot have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

With respect to argument (A), this has been responded to in the body of the rejection in paragraph 8 above.

With respect to argument (B), this has been responded to in the body of the rejection in paragraph 9 above.

It is noted that applicant's argument on page 11 referring to a notched izod value of “about 1.1 ft-lb/in. at low temperatures” is not commensurate with the scope of amended claim 1

which recites that the notched izod value is “up to about 1.0 ft-lb/in. at low temperatures below zero degrees fahrenheit” or amended claim 11 which recites that the notched izod value is “at least about 1.0 ft-lb/in in sub-zero temperatures.” Hence, that argument is not persuasive.

With respect to argument (C), applicant has not amended claim 12 as indicated on page 11 of applicant’s argument.

Nevertheless, if the applicant had amended claim 12 as suggested on page 11 of applicant’s argument, it is the examiner’s position that although Troy et al in view of di Leone et al are silent with respect to the specific numerical properties presently claimed, it is intrinsic that the prior art exhibits such properties since they meet the present compositional limitations and a material and its properties are inseparable. Therefore, applicant’s arguments are not persuasive.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Correspondence*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 15, 2004

vr



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